

Docket No.: NHL-KEH-26A  
Serial No.: 10/789,927  
Customer No.: 52671

**REMARKS**

The Office Action dated December 12, 2006, has been reviewed in detail and the application has been amended in the sincere effort to place the same in condition for allowance. Reconsideration of the application and allowance in its amended form are requested based on the following remarks.

Applicant retains the right to pursue broader claims under 35 U.S.C. §120.

Applicant has provided a unique solution with respect to problems regarding CUTTING INSERT AND USE THEREOF. Applicant's solution is now claimed in a manner that satisfies the requirements of 35 U.S.C. §103 and §112.

**Rejection of Claim 1 Under 35 U.S.C. §103:**

Claim 1 was rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri.

It is respectfully submitted that Claim 1 distinguishes over these references. Amended Claim 1 recites: "said at least one cutting body being joined to said base body by a non-metallic adhesive

configured to withstand high temperatures generated during use of the cutting insert in recessing or copy turning metal workpieces."

Neither of the applied references teaches or suggests this limitation.

However, although neither Lagerberg nor Komanduri makes any mention of using adhesive to join the wafer 24 with its corresponding base body 23, the Examiner insists in the Office Action that Lagerberg still teaches the use of an adhesive. Specifically, the Examiner states on page 4 of the outstanding Office Action the following:

Regarding the limitation "said at least one cutting body being joined to said base body by an adhesive configured to withstand high temperatures generated during use of the cutting insert in recessing or copy turning metal workpieces", Lagerberg teaches the wafer (24) being secured to the body (23) preferably through welding or soldering ('606, col. 2, lines 30-33). Examiner points out that Dictionary.com defines "adhesive" as "a substance that causes something to adhere", therefore Lagerberg's teaches the claimed subject matter.

With respect to the Examiner's assertion that welding teaches or suggests an adhesive, Applicant also researched the definition of "adhesive" on Dictionary.com and found several definitions. One of the definitions was "a substance that causes something to adhere, as glue or rubber cement" (emphasis added). In making her assertion, the Examiner failed to fully quote the definition, leaving out the

specific examples - glue and rubber cement - that Dictionary.com utilizes to more accurately define what is meant by a substance that causes something to adhere. Other definitions for "adhesive" on Dictionary.com make specific reference to glues and pastes as being adhesives, or mention that an adhesive is something that is sticky or gummy. In stark contrast, "weld" or "welding" is clearly defined by Dictionary.com in a different manner. According to Dictionary.com, there is one main or dominant definition of "weld" or "welding" which relates to the joining of metals by heat or pressure, examples of which are as follows:

"To join (metals) by applying heat, sometimes with pressure and sometimes with an intermediate or filler metal having a high melting point."

"The union of two metal parts by welding."

"Fastening two pieces of metal together by softening with heat and applying pressure."

"To unite or fuse (as pieces of metal) by hammering, compressing, or the like, esp. after rendering soft or pasty by heat, and sometimes with the addition of fusible material like or unlike the pieces to be united."

"A metal joint formed by softening with heat and fusing or hammering together."

"Join together by heating; 'weld metal.'"

The primary definition therefore relates to the union of metals by heat and pressure, wherein the united metals have their composition altered to cause the joining. A secondary definition of "weld" or

"welding" is also provided, examples of which are as follows:

"To bring into close association or union."

"To bring into complete union, harmony, agreement, etc."

"Unite closely or intimately; 'Her gratitude welded her to him.'"

Although these definitions appear broader than the primary definition and to encompass anything that unifies or brings items close, they clearly are directed to describing intangible connections, such as love, friendship, and sharing of like views or opinions, and are therefore not applicable to the present discussion.

In view of the above, one would be hard pressed to not conclude that an adhesive and a weld are two entirely different manners of joining two or more objects. Adhesives are generally sticky, gummy, or tacky substances, or substances that can be rendered so by water or heat, that adhere to the surfaces of the objects to be joined to join them. A weld, on the other hand, involves the melting of two metals to fuse or join the metals together, sometimes with the use of a filler metal. A weld therefore alters the structure or composition of the metal objects to be joined, whereas an adhesive does not as it simply adheres to the surfaces of the objects to join them together. It is therefore respectfully submitted that Lagerberg does not teach the use of an adhesive by

the mentioning of welding.

The Examiner also cites "soldering" as teaching the use of an adhesive. Dictionary.com provides several definitions of solder which can be easily broken down into two categories. The primary definitions for each of the various dictionaries referenced relate solely to the fusing or joining of metal objects with a metal alloy, which is the solder material. These definitions are as follows:

"Any of various alloys fused and applied to the joint between metal objects to unite them without heating the objects to the melting point."

"To join (metal objects) with solder."

"To unite things with solder."

"Any of various fusible alloys, usually tin and lead, used to join metallic parts."

"To unite or repair (parts, for example) with solder."

"To unite or repair something with solder."

"An alloy (usually of lead and tin) used when melted to join two metal surfaces."

"Join or fuse with solder; 'solder these two pipes together.'"

In contrast, the secondary definition for each of the dictionaries referenced is a much broader definition which relates to the joining of intangibles, such as friendships, causes, or fates, much like the secondary definition for welding. These definitions are as follows:

"Anything that joins or unites: *the solder of their common cause.*"

"To join closely and intimately: *two fates inseparably soldered by misfortune.*"

"To mend; repair; patch up."

"To become soldered or united; grow together."

"Something that joins or cements."

"To join or unite: *The agreement soldered the factions into an alliance.*"

"To be joined or united."

Although these are broad definitions, they are clearly delineated from the primary technical definition of solder as used in metallurgy and industry. The soldering disclosed by Lagerberg falls under this much narrower, primary definition of solder, which definition is well known and understood by even persons with only a high school-level education. This definition is clearly different from the definition of adhesive as the terms are primarily defined and understood. It is respectfully submitted that solder is a unique term referring to a specific type of joining structure, whereas adhesive refers to sticky or tacky substances most commonly identified as glues, pastes, etc. It is therefore respectfully submitted that Lagerberg does not teach the use of an adhesive by the mentioning of soldering.

Further, if the Examiner's broad rendering of the term "adhesive" is accepted, then it would be fair to conclude that anything that causes two objects to adhere to one another would be sufficient to be considered an adhesive. For example, would human

sweat be considered an adhesive since it causes skin to stick to certain surfaces or objects upon contact, such as a leather seat on a hot day? It is respectfully submitted that the average person, let alone a person of ordinary skill in a technological art, would not consider sweat to be an "adhesive" in the most common understanding of the word, even though sweat, at times, can exhibit adhesive-like characteristics. It is therefore respectfully submitted that the common definition of an adhesive as being a sticky substance, such as a glue, should be utilized in understanding the claim, which common definition excludes the specific connecting methods of welding and soldering.

In addition, Claim 1 has been amended to recite "said at least one cutting body being joined to said base body by a non-metallic adhesive configured to withstand high temperatures generated during use of the cutting insert in recessing or copy turning metal workpieces." Both welding and soldering involve metallic joints or joining methods using metallic materials. It is therefore respectfully submitted that neither Lagerberg nor Komanduri teaches or suggests such a limitation. Claim 1 is therefore believed to distinguish over Lagerberg and Komanduri, either taken individually or in any

reasonable combination thereof.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

**Rejection of Claims 14 and 29 Under 35 U.S.C. §103:**

Claims 14 and 29 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri, and further in view of U.S. Patent 5,205,680 to Lindstedt. In general, the Examiner stated that the combination of Lagerberg and Komanduri discloses the invention as claimed except for the cutting body having a maximum diameter in the range of  $4 \pm 0.05$  mm to  $10 \pm 0.05$  mm.

Lindstedt, as best understood, shows a metal cutting insert that has rounded or circular cutting edges. As can be seen in Figure 4 of Lindstedt, the cutting insert is a one-piece cutting insert that is clamped into place. Lindstedt does not disclose the use of an adhesive.

Claim 14 depends from what is believed to be an allowable Claim 1 for the reasons set forth above. Since neither Lagerberg, Komanduri, nor Lindstedt teaches the use of an adhesive, Claims 1



and 14 distinguish over each of these references.

Similarly, amended Claim 29 recites the following: "said at least one cutting body being joined to said base body by an organic adhesive." Again, none of the applied references teaches or suggests an adhesive, let alone an organic adhesive. Claim 29 is therefore believed to distinguish over the applied references.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

**Rejection of Claims 23 and 24 Under 35 U.S.C. §103:**

Claims 23 and 24 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri, and further in view of U.S. Patent 5,205,680 to Lindstedt and U.S. Patent 5,868,530 to Shouse. In general, the Examiner stated that the combination of Lagerberg, Komanduri, and Lindstedt discloses the invention as claimed except for an adhesive comprising an organic adhesive and/or dimethacrylate ester. The Examiner stated that Shouse teaches securing a cutting tip to a cutting tip support by adhesive. Specifically, Shouse states the following in column 1, lines 19-23:

The typical cutting tool comprises a cutting tip of hard material such as diamond or carborundum detachably secured to a cutting tip support, which in turn is releasably held in position by a shank. Commonly, the cutting tip is secured directly to the support by adhesive or a bolt.

It is first respectfully submitted that there is no suggestion to combine Shouse with the modified device of Lagerberg. As argued above, neither Lagerberg, Komanduri, nor Lindstedt teaches or suggests the use of adhesive. Lagerberg teaches welding or soldering, which are clearly not adhesives as the term is understood. In that regard, MPEP 2143 requires that to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Further, MPEP 2143 states that the "teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." The suggestion to combine Shouse with the combination of Lagerberg, Komanduri, and Lindstedt is not found in Shouse or any one of Lagerberg, Komanduri, or Lindstedt.

As pointed out by the Examiner, Shouse does disclose the use

of an adhesive in attaching a cutting tip. However, Shouse does not teach or suggest replacing a welded or soldered connection as taught by Lagerberg with an adhesive connection. Likewise, Lagerberg does not teach or suggest using an adhesive as taught by Shouse to replace the welded or soldered connection. In this regard, it is important to note the decision of the Court of Appeals, Federal Circuit (CAFC) in its opinion in *In re Howard Sernaker*, 702 F. 2d 989, wherein, a Patent and Trademark Board of Appeal affirmance of an Examiner's rejection under 35 U.S.C. §103, based on a combination of references, was overturned.

In *Sernaker*, the invention involved related to a method for producing embroidered "emblems" which closely resembled emblems of the prior art embroidered with different colored thread. In the claims on appeal, a sculptured embroidery was produced from a single colored thread (e.g., white); a heat-transferable transfer print (e.g., a decal) was provided; the sculptured embroidery and the transfer print were mated and aligned; and color was transferred from the print to the embroidery by the application of heat.

Sculptured one-color embroideries were known in the prior art, as was the heat transferable printing process. However, the CAFC

held the claims on appeal nonobvious, stating the relevant tests to be:

"(a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and

(b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable combination."

The CAFC recognized that the separate elements of the white sculptured embroidery and the heat-transferable dyeing process existed in the prior art. However, they pointed to the absence, in the references themselves or in the prior art general knowledge as a whole, of any recognition or suggestion that further improvements could be achieved by combining these known elements in the manner taught and claimed in the application (e.g., in a mated and aligned fashion).

It is believed that the decision of *Sernaker* is applicable in the present application, as there is nothing in either of the two references which teaches or suggests that the references be combined.

Further, since there is nothing in the applied references to

teach that they be combined, it is also submitted that the only motivation to combine the applied references is the present disclosure itself, and such hindsight analysis of the available art is considered improper. At this juncture, Applicants wish to point out the decision in another court case which is considered to be relevant to the prosecution of the instant application.

In *In re Deminski*, 230 USPQ 313 (1986), the CAFC overturned a decision of the Board of Patent Appeals and Interferences regarding obviousness of the invention in view of prior references. In *In re Deminski*, the Board upheld the Examiner's rejection of Claims 17, 18 and 21 in view of obviousness over the prior art. These claims have the limitation that the valve sets in the valve chambers be connected to permit withdrawal as a unit. The Board argued that if the Pocock reference would have attached the valve stem to the valve structure, the valve assembly would have been removable as a unit. The CAFC found nothing in the references to "suggest the desirability, and thus the obviousness" of designing the valve assembly to be removable, and stated that "the only way the board could have arrived at its conclusion was through hindsight analysis by reading into the art Deminski's own teachings. Hindsight

analysis is clearly improper, since the statutory test is whether the subject matter as a whole would have been obvious at the time the invention was made."

Also, Shouse states that cutting tip is "detachably secured" to the cutting tip support by the adhesive or bolt. It is respectfully submitted that Shouse therefore teaches away from the use of welding or soldering as these types of connections are meant to nearly permanently secure or attach one object to another. A weld, for example, literally fuses two objects together to prevent or, at the very least, absolutely minimize detachment or separation. Lagerberg therefore teaches a permanent or nearly permanent connection where detachment is apparently undesirable based on the choice of welding or soldering for the connection. Shouse teaches the exact opposite in that Shouse suggests the use of an adhesive or a bolt to form a detachable connection. If Lagerberg's weld or solder were used by Shouse to connect the cutting tip, the detachability of the connection would be lost. Likewise, if Shouse's detachable connection means were used by Lagerberg to connect the cutting tip, the permanence or near permanence of the welded or soldered connection would be lost. There is therefore no suggestion to combine the references in

either reference as they teach away from one another, and also no expectation of success in their combination since the connecting means of each is incompatible with the desired type of connection of the other.

It is also respectfully submitted that the above teaching of Shouse further supports the general understanding or definition of adhesive argued above since Shouse suggests that an adhesive can be utilized to form a detachable connection. Shouse's teaching of the suitability of adhesive in forming a detachable connection is undoubtedly based on the understanding that adhesives, as generally understood, are sticky or tacky substances that join two objects together without fusing or materially altering them, such as is done in welding. Shouse apparently understands that adhesive connections do not encompass welded or soldered connections, or else he would undoubtedly never have suggested that adhesives in general would be suitable for use in forming a detachable connection. Such a teaching is believed to be further evidence that adhesives have a generally understood meaning that does not include the narrowly-defined connecting methods of welding and soldering.

In addition, none of the applied references teaches or suggests

an adhesive comprising dimethacrylate ester. Lagerberg, Komanduri, and Lindstedt clearly make no mention of such a feature. Shouse, as stated above, does briefly mention the use of an adhesive, but Shouse does not mention a specific adhesive or even a group of adhesives from which to choose a specific adhesive. It is respectfully submitted that there are thousands and thousands of adhesives in existence, and the mere mention of adhesive cannot possibly be considered as a teaching for the use of a very specific adhesive. A person of ordinary skill in the art could not reasonably be expected to try every possible adhesive out of the thousands available to eventually arrive at an adhesive comprising dimethacrylate ester.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

**Rejection of Claims 2 and 4 Under 35 U.S.C. §103:**

Claims 2 and 4 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri, and further in view of U.S. Patent 5,205,680 to Lindstedt and U.S. Patent 5,868,530 to Shouse and



Docket No.: NHL-KEH-26A  
Serial No.: 10/789,927  
Customer No.: 52671

U.S. Patent 4,552,491 to Parker. In general, the Examiner stated that the combination of Lagerberg, Komanduri, Lindstedt, and Shouse discloses the invention as claimed except for the cutting body having a perpendicular circular truncated cone shape with one end surface being smaller in diameter than the opposite end surface. The Examiner states that Parker shows a cutting insert with such a truncated cone shape.

It is respectfully submitted that the present combination fails as the base combination of Lagerberg, Komanduri, Lindstedt, and Shouse fails for the reasons set forth herein above. The combination of Lagerberg, Komanduri, Lindstedt, Shouse, and Parker therefore does not render the claims obvious as there is no suggestion to combine the references and they do not disclose all of the features of the claims, as required by MPEP 2143.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

**Rejection of Claims 6 and 7 Under 35 U.S.C. §103:**

Claims 6 and 7 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S.

Docket No.: NHL-KEH-26A  
Serial No.: 10/789,927  
Customer No.: 52671

Patent 4,714,385 to Komanduri, and further in view of U.S. Patent 5,205,680 to Lindstedt and U.S. Patent 5,868,530 to Shouse and U.S. Patent 4,552,491 to Parker and European Publication No. 0552714. In general, the Examiner stated that the combination of Lagerberg, Komanduri, Lindstedt, Shouse, and Parker discloses the invention as claimed except for except for the specific angle of the partial circle. The Examiner states that EP '714 shows such a partial circle angle.

It is respectfully submitted that the present combination fails as the base combination of Lagerberg, Komanduri, Lindstedt, Shouse, and Parker fails for the reasons set forth herein above. The combination of Lagerberg, Komanduri, Lindstedt, Shouse, Parker, and EP '714 therefore does not render the claims obvious as there is no suggestion to combine the references and they do not disclose all of the features of the claims, as required by MPEP 2143.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

**Rejection of Claim 13 Under 35 U.S.C. §103:**

Claim 13 was rejected under 35 U.S.C. §103 as being

Docket No.: NHL-KEH-26A  
Serial No.: 10/789,927  
Customer No.: 52671

unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri, and further in view of U.S. Patent 5,205,680 to Lindstedt and U.S. Patent 5,868,530 to Shouse, U.S. Patent 4,552,491 to Parker, European Publication No. 0552714, and U.S. Publication 2002/0131832 to Morsch. In general, the Examiner stated that the combination of Lagerberg, Komanduri, Lindstedt, Shouse, Parker, and EP '714 discloses the invention as claimed except for one groove, defined by raised portions on either side, extending transversely to the longitudinal axis of the insert. The Examiner states that Morsch shows such a groove.

It is respectfully submitted that the present combination fails as the base combination of Lagerberg, Komanduri, Lindstedt, Shouse, Parker, and EP '714 fails for the reasons set forth herein above. The combination of Lagerberg, Komanduri, Lindstedt, Shouse, Parker, EP '714, and Morsch therefore does not render the claim obvious as there is no suggestion to combine the references and they do not disclose all of the features of the claim, as required by MPEP 2143.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

**Rejection of Claim 19 Under 35 U.S.C. §103:**

Claim 19 was rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri and further in view of U.S. Patent 6,217,263 to Wiman.

Claim 19 recites "said at least one cutting body being joined to said base body by a non-metallic adhesive configured to withstand high temperatures generated during use of the cutting insert in recessing or copy turning metal workpieces." As discussed above with respect to Claim 1, neither Lagerberg nor Komanduri teaches or suggests the use of an adhesive, especially not a non-metallic adhesive. Wiman also does not teach or suggest the use of an adhesive to join a cutting body to a base body as the cutting insert of Wiman is a one-piece, metal cutting insert. It is respectfully submitted that Claim 19 is not obvious in view of Lagerberg, Komanduri, and Wiman as the references do not teach all of the features of the claim as required by MPEP 2143.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

**Rejection of Claims 27 and 28 Under 35 U.S.C. §103:**

Claims 27 and 28 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri, and further in view of U.S. Patent 6,217,263 to Wiman and U.S. Patent 5,868,530 to Shouse. In general, the Examiner stated that the combination of Lagerberg, Komanduri, and Wiman discloses the invention as claimed except for an adhesive comprising an organic adhesive and/or dimethacrylate ester.

Claims 27 and 28 are believed to not be rendered obvious by the combination of Lagerberg, Komanduri, Wiman, and Shouse for the same reasons as set forth herein above with respect to Claims 23 and 24. It is respectfully submitted that Claims 27 and 28 are not obvious in view of Lagerberg, Komanduri, Wiman, and Shouse as there is no suggestion to combine the references and they do not disclose all of the features of the claims, as required by MPEP 2143.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

**Rejection of Claim 20 Under 35 U.S.C. §103:**

Claim 20 was rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri, and further in view of U.S. Patent 6,217,263 to Wiman, U.S. Patent 5,868,530 to Shouse, and U.S. Patent 5,205,680 to Lindstedt. In general, the Examiner stated that the combination of Lagerberg, Komanduri, Wiman, and Shouse discloses the invention as claimed except for the cutting body having a maximum diameter in the range of  $4 \pm 0.05$  mm to  $10 \pm 0.05$  mm. Lindstedt, as discussed above, shows a cutting body with a circular cutting edge having a diameter of 3-5 mm.

It is respectfully submitted that the present combination fails as the base combination of Lagerberg, Komanduri, Wiman, and Shouse fails for the reasons set forth herein above. The combination of Lagerberg, Komanduri, Wiman, Shouse, and Lindstedt therefore does not render the claim obvious as there is no suggestion to combine the references and they do not disclose all of the features of the claim, as required by MPEP 2143.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

**Rejection of Claims 30 and 31 Under 35 U.S.C. §103:**

Claims 30 and 31 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri, and further in view of U.S. Patent 5,205,680 to Lindstedt and U.S. Patent 4,552,491 to Parker. In general, the Examiner stated that the combination of Lagerberg, Komanduri, and Lindstedt discloses the invention as claimed except for the cutting body having a perpendicular circular truncated cone shape with one end surface being smaller in diameter than the opposite end surface. The Examiner states that Parker shows a cutting insert with such a truncated cone shape.

It is respectfully submitted that the present combination fails as the base combination of Lagerberg, Komanduri, and Lindstedt fails for the reasons set forth herein above. The combination of Lagerberg, Komanduri, Lindstedt, and Parker therefore does not render the claims obvious as there is no suggestion to combine the references and they do not disclose all of the features of the claims, as required by MPEP 2143.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.

**Rejection of Claims 32 and 33 Under 35 U.S.C. §103:**

Claims 32 and 33 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri, and further in view of U.S. Patent 5,205,680 to Lindstedt, U.S. Patent 4,552,491 to Parker, and European Publication No. 0552714. In general, the Examiner stated that the combination of Lagerberg, Komanduri, Lindstedt, and Parker discloses the invention as claimed except for except for the specific angle of the partial circle. The Examiner states that EP '714 shows such a partial circle angle.

It is respectfully submitted that the present combination fails as the base combination of Lagerberg, Komanduri, Lindstedt, and Parker fails for the reasons set forth herein above. The combination of Lagerberg, Komanduri, Lindstedt, Parker, and EP '714 therefore does not render the claims obvious as there is no suggestion to combine the references and they do not disclose all of the features of the claims, as required by MPEP 2143.

In view of the above, reconsideration and withdrawal of the present rejection is respectfully requested.



**Rejection of Claim 34 Under 35 U.S.C. §103:**

Claim 34 was rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 4,632,606 to Lagerberg in view of U.S. Patent 4,714,385 to Komanduri, and further in view of U.S. Patent 5,205,680 to Lindstedt, U.S. Patent 4,552,491 to Parker, European Publication No. 0552714, and U.S. Publication 2002/0131832 to Morsch. In general, the Examiner stated that the combination of Lagerberg, Komanduri, Lindstedt, Parker, and EP '714 discloses the invention as claimed except for one groove, defined by raised portions on either side, extending transversely to the longitudinal axis of the insert. The Examiner states that Morsch shows such a groove.

It is respectfully submitted that the present combination fails as the base combination of Lagerberg, Komanduri, Lindstedt, Parker, and EP '714 fails for the reasons set forth herein above. The combination of Lagerberg, Komanduri, Lindstedt, Parker, EP '714, and Morsch therefore does not render the claim obvious as there is no suggestion to combine the references and they do not disclose all of the features of the claim, as required by MPEP 2143.

In view of the above, reconsideration and withdrawal of the

present rejection is respectfully requested.

**Rejection of Claims 14, 23, 24, 27, 28 Under 35 U.S.C. §112:**

Claim 14 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 14 has been amended herein in a manner believed to overcome the rejection.

Claims 23, 24, 27, and 28 were rejected under 35 U.S.C. §112, first paragraph. Specifically, the Examiner stated the following: "Claims 23, 24, 27, and 28 recite 'organic adhesive' and 'adhesive comprising dimethacrylate ester'. Further review of the Specification/drawings do not mention this claimed subject matter."

In anticipation of such a rejection, Applicant stated in the preliminary amendment filed November 1, 2006, with the Request for Continued Examination, the following:

Support for these limitations can be found in U.S. Patent 4,532,270 to Rossi et al., column 3, lines 24-30 and 53-56. U.S. Patent 4,532,270 is listed on page 19, lines 16-18, of the specification as originally filed and was incorporated by reference therein. A copy of U.S. Patent 4,532,270 is submitted herewith for the Examiner's reference.

Docket No.: NHL-KEH-26A  
Serial No.: 10/789,927  
Customer No.: 52671

The Examiner replied to this statement on page 19 of the outstanding Office Action as follows:

In response to Applicant's argument (page 13, 2nd paragraph) that "It should be noted that Claims 23 and 27 recite that the "adhesive comprises an organic adhesive," and Claims 24 and 28 recite that the "adhesive comprises dimethacrylate ester." It is respectfully submitted that the prior art of record does not teach or suggest these limitations. Support for these limitations can be found in U.S. Patent 4,532,270 to Rossi et al. column 3, lines 24-30 and 53-56. U.S. Patent 4,532,270 is listed on page 19, lines 16-18, of the specification as originally filed and was incorporated by reference therein..". Applicant respectfully points out that the invention that the Applicant claims should be disclosed adequately and accurately. Merely citing Patents does not mean what is disclosed in the body of the patents cited is also the invention of the Applicant.

As stated above, U.S. Patent 4,532,270 was listed in the specification as originally filed and was incorporated by reference therein. The incorporation by reference is set forth in the application on page 18, lines 12-14: "All of the patents, patent applications and publications recited herein, and in the Declaration attached hereto, are hereby incorporated by reference as if set forth in their entirety herein." In accordance with 37 CFR §1.57 and MPEP §608.01(p), U.S. patents or U.S. patent application publications, and thus the material disclosed therein, may be incorporated by reference in a U.S. patent application. Contrary to the Examiner's assertion,

Docket No.: NHL-KEH-26A  
Serial No.: 10/789,927  
Customer No.: 52671

Applicant has not merely cited U.S. Patent 4,532,270, but has incorporated it by reference. It is therefore respectfully submitted that the Applicant has incorporated U.S. Patent 4,532,270 by reference into the present application, and thus has provided support for the limitations of Claims 23, 24, 27, and 28.

In addition, Claims 1 and 19 were amended herein to include the term "non-metallic" to further describe the adhesive recited therein. Support for this term may be found in the specification as originally filed on page 5, lines 11-14, which mention that suitable adhesives are "on the basis of epoxy resin or acrylic resin...." It is respectfully submitted that these resins are examples of non-metallic adhesives. Further examples of non-metallic adhesives may be found in the patents cited in the application and incorporated by reference therein, such as those listed on pages 19 and 20 of the application.

**Petition for Extension of Time under 37 C.F.R. §1.136(a):**

Applicant hereby petitions for a one-month extension of time, from March 12, 2007 until April 12, 2007, in which to file the present response. A payment in the amount of \$120.00, representing the one-month extension fee for a large entity, is submitted herewith.

Docket No.: NHL-KEH-26A  
Serial No.: 10/789,927  
Customer No.: 52671

**Art Made of Record:**

The prior art made of record and not applied has been carefully reviewed, and it is submitted that it does not, either taken singly or in any reasonable combination with the other prior art of record, defeat the patentability of the present invention or render the present invention obvious. Further, Applicant is in agreement with the Examiner that the prior art made of record and not applied does not appear to be material to the patentability of the claims currently pending in this application.

In view of the above, it is respectfully submitted that this application is in condition for allowance, and early action towards that end is respectfully requested.

**Leave to Delay Treatment of Formal Objections Until Allowable Subject Matter is Indicated:**

In accordance with 37 C.F.R. §1.111, it is hereby respectfully requested that any objections or requirements not fully treated and set forth in the outstanding Office action that relate to form and are not necessary to further consideration of the now pending claims, be held in abeyance until allowable subject matter is indicated.

Docket No.: NHL-KEH-26A  
Serial No.: 10/789,927  
Customer No.: 52671

**Art Made of Record:**

The prior art made of record and not applied has been carefully reviewed, and it is submitted that it does not, either taken singly or in any reasonable combination with the other prior art of record, defeat the patentability of the present invention or render the present invention obvious. Further, Applicant is in agreement with the Examiner that the prior art made of record and not applied does not appear to be material to the patentability of the claims currently pending in this application.

In view of the above, it is respectfully submitted that this application is in condition for allowance, and early action towards that end is respectfully requested.

**Summary and Conclusion:**

It is submitted that Applicant has provided a new and unique CUTTING INSERT AND USE THEREOF. It is submitted that the claims are fully distinguishable from the prior art. Therefore, it is requested that a Notice of Allowance be issued at an early date.

If mailed, I, the person signing this certification below, hereby certify that this correspondence is being deposited with the United

Docket No.: NHL-KEH-26A  
Serial No.: 10/789,927  
Customer No.: 52671

States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the date indicated in the certification of mailing on the transmittal letter sent herewith, or if facsimile transmitted, I, the person signing this certification below, hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated in the certification of facsimile transmission on the transmittal letter which is being facsimile transmitted herewith.

Respectfully submitted,

/Nils H. Ljungman/

Nils H. Ljungman, Esq.  
Attorney for the Applicant  
Reg. No. 25,997  
Name of person signing certification  
Nils H. Ljungman & Associates  
P.O. Box 130  
Greensburg, PA 15601-0130  
Telephone: (724) 836-2305  
Facsimile: (724) 836-2313